

**REMARKS****Summary of the Office Action**

In the Office Action, the rejection of claims 1-11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Pub. No. 2001/0052386 to *Treleaven*, has been withdrawn.

However, claims 1-11 and 25-29 have now been rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, as being indefinite.

Claims 1-11 and 25-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,057,019 to *Barry* in view of *Treleaven*.

**Summary of the Response to the Office Action**

Applicant proposes amending claims 1 and 25, and canceling claims 4, 6-11 and 28. Accordingly, claims 1-3, 5, 25-27 and 29 are pending for further consideration, with claims 12-24 being withdrawn from consideration per the Restriction Response filed April 21, 2005.

**35 U.S.C. § 112, 2<sup>nd</sup> Paragraph Rejection**

In the Office Action, claims 1-11 and 25-29 have now been rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, as being indefinite.

Specifically, the Examiner indicates that the phrases “inner and outer sections,” “inner section,” and “outer section,” in claims 1, 4, 6, 9, 25 and 28 are unclear and have not been mentioned in the specification or drawings.

With regard to the noted language of claims 1, 4, 6, 9, 25 and 28, Applicant respectfully directs the Examiner’s attention to Paragraphs 11-13 of the original specification which clearly describe the “inner and outer sections,” “inner section,” and “outer section.” For further clarity, Applicant has clearly described the noted sections of the instantly redeemable coupon in the discussion below for allowance of pending claims 1-3, 5, 25-27 and 29 over the art of record.

Applicant therefore respectfully requests withdrawal of the rejection of claims 1-11 and 25-29 under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph.

**All Claims are Allowable**

In the Office Action, claims 1-11 and 25-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Barry* in view of *Treleaven*. Applicant respectfully traverses the rejection of pending claims 1-3, 5, 25-27 and 29 for the following reasons.

With regard to independent claim 1, Applicant respectfully asserts that *Barry* and *Treleaven*, viewed either singly or in combination, do not teach or fairly suggest a paperback rider instantly redeemable coupon (IRC) including, "a liner including inner and outer sections on a first face thereof; a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner; a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof, said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first face of said first laminate being affixed to said outer section of said liner to substantially enclose said booklet between said first laminate and said liner; and an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate adhesively affixed thereon, said second laminate including inner and outer sections on a first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to said outer section of said second face of said first laminate, each of said outer sections of said second laminate including perforations for permitting separation and removal of said IRC from said paperback rider IRC," as recited in independent claim 1, as amended.

Support for these features recited in claim 1 can be found at least in Paragraphs 0010-0013, and 0027-0036 of the originally filed specification, and in Figs. 2-5 of the originally filed drawings. Specifically, as shown in Figs. 2 and 3, the present invention provides a paperback rider instantly redeemable coupon (IRC) including a liner (i.e. film) 26 having inner and outer sections on a first face thereof, and a booklet 12 including first and second surfaces. The first (i.e. inner) surface of the booklet may be disposed substantially adjacent the inner section on the first face of the liner. A first laminate (i.e. clear film) 32 may be adhesively affixed to the second (i.e. outer) surface of the booklet and include inner and outer sections on first and second faces thereof. As shown, the inner section (i.e. inner area of inner face) of the first face of the first laminate may be affixed to the booklet and the outer section (i.e. outer ends

of inner face) of the first face of the first laminate may be affixed to the outer section of liner 26 to substantially enclose the booklet between the first laminate and the liner. An IRC 14 may be disposed substantially adjacent the inner section on the second (i.e. outer) face of the first laminate (i.e. clear film 32) and have a second laminate (i.e. clear film 28) adhesively affixed thereon. The second laminate may include inner and outer sections on a first face thereof. The inner section (i.e. area adjacent or between perforations 38) of the second laminate may be affixed to the IRC and the outer section (i.e. area beyond perforations 38) of the second laminate may be affixed to the outer section of the second face of the first laminate. As discussed in Paragraph 29 of the specification and illustrated in Fig. 2, each of the outer sections of the second laminate include perforations 38 for permitting separation and removal of the IRC from the paperback rider IRC.

The Office Action cites *Barry* and *Treleaven* as teaching or suggesting the paperback rider instantly redeemable coupon (IRC) recited in claims 1-11.

*Barry*, as illustrated in Figs. 1 and 2 thereof, discloses a booklet 8 disposed between a cover sheet 5 and a base 6. As correctly acknowledged in the Office Action, *Barry* does not disclose the use of an IRC with the booklet arrangement.

*Treleaven*, as illustrated in Figs. 1 and 2 thereof, discloses a multi-ply resealable label 100. As discussed in Paragraph 0034 of *Treleaven*, in order to use label 100, the label may be applied to a suitable substrate such as a container by means of a base adhesive 104. When a user wishes to access the information on the inside of label 100, the user may grasp the corner or pull tab 103 of the combined top panel 130 and laminate cover 150 adjacent the tab 137. The user may then pull the corner 103 toward the hinge 106 (as illustrated from right to left), thereby causing the laminate adhesive portion 154A to peel away from the varnish coated tab 137. The underside of the top panel 130 preferably includes printed indicia 118 such as a bar code. The top panel 130 may be repeatedly opened and closed by rejoining the adhesive portion 154A with the tab 137. The area of adhesive 154A exposed upon opening the label 100 may be limited to that needed to ensure reliable closure of the label.

Thus as clearly described in Paragraph 0034 of *Treleaven*, label 100 is designed to be repeatedly opened and closed for accessing information 118 on the bottom of top panel 130, with varnish coated tab 137 functioning as a resealing means.

In a further embodiment of resealable label 100, as illustrated in Figs. 6 and 7 and discussed in Paragraphs 0042-0044 of *Treleaven*, it is indicated that label 100 may be instead formed using folded leaflets 140B, which are formed from a sheet 131B including J-shaped cuts 136B formed therein. A continuous strip or dots of adhesive 134B corresponding to the adhesive strips 134 (see Fig. 1) are applied along the sheet 131B. Adhesive patches 138B are applied to sheet 131B in locations corresponding to the adhesive patches 138. Varnish patches 139B (similar to varnish patch 139 of Figs. 1 and 2) are printed on the opposite side of sheet 131B adjacent the cut lines 136B and in locations corresponding to varnish 139 (see again Fig. 1). The sheet 131B is folded along a fold 135B to divide the sheet 131B into a top panel 130B corresponding to the top panels 130 (see Fig. 1) and a bottom panel 110B corresponding to the base labels 110 (see Fig. 1). The adhesive 134B adheres panels 130B and 110B adjacent the fold line 135B.

Thus as clearly described in Paragraphs 0042-0044 of *Treleaven*, the labels illustrated in the Figs. 6 and 7 embodiment are virtually identical to the label of Fig. 1, except that the Figs. 6 and 7 labels are formed of a folded sheet 131B, whereas the labels of Fig. 1 are formed of bonded layers as shown in Fig. 1.

In distinct contrast to the teachings of *Treleaven*, for the present invention, the paperback rider instantly redeemable coupon (IRC) 10 as illustrated in Figs. 2 and 3, clearly includes a second laminate (i.e. clear film 28), with each of the outer sections of the second laminate including perforations 38 for permitting separation and removal of the IRC from the paperback rider IRC.

As clearly illustrated in Fig. 1 (as well as Figs. 6 and 7) of *Treleaven*, the die cut 136 merely allows label 100 to be repeatedly opened and closed for accessing information 118 on the bottom of top panel 130, with varnish coated tab 137 functioning as a resealing means. Yet further, the label design of *Treleaven* clearly includes the use of adhesive layer 134 for retaining top panel 130 in place without permitting removal thereof.

Thus, as emphasized above, *Treleaven* clearly does not teach or suggest, a paperback rider instantly redeemable coupon (IRC), wherein “each of said outer sections of said second laminate including perforations for permitting separation and removal of said IRC from said paperback rider IRC,” as recited in independent claim 1, as amended.

Yet further, the present invention paperback rider instantly redeemable coupon (IRC) includes five distinct layers, as also clearly recited in independent claim 1, as amended.

Specifically, as shown in Fig. 2, the present invention paperback rider instantly redeemable coupon (IRC) 10 includes (1) a first liner layer 26, (2) a booklet layer 12, (3) a first laminate (i.e. clear film) layer 32, (4) an IRC 14, and (5) a second laminate (i.e. clear film) layer 28. As discussed in paragraph 0029 of the specification, in order to use paperback rider instantly redeemable coupon (IRC) 10, a cashier may remove IRC 14 by grasping one corner and tearing along the two vertical perforations 38. The booklet 12, encased within film 26 and clear film 32, would be left intact still firmly secured to the package or product for later removal by the consumer.

On the contrary, *Barry* discloses only a booklet 8 disposed between a cover sheet 5 and a base 6, without the use of an IRC with the booklet arrangement.

Further, *Treleaven* clearly does not teach or suggest the five distinct layers which form the present invention paperback rider instantly redeemable coupon (IRC) 10. Instead, *Treleaven* merely discloses a label 100 designed to be repeatedly opened and closed for accessing the information 118 on the bottom of top panel 130, with varnish coated tab 137 functioning as a resealing means. *Treleaven* further discloses various embodiments of label 100, of which the Fig. 1 embodiment includes a variety of stacked layers and the Fig. 6 embodiment includes a label formed of folded layers.

Based upon the express disclosure of *Treleaven*, label 100 has absolutely nothing in common with the present invention paperback rider instantly redeemable coupon (IRC) 10, as recited in independent claim 1. Further, as discussed above, in addition to the fact that *Barry* and *Treleaven* fail to teach or suggest each of the outer sections of the second laminate including perforations 38 for permitting separation and removal of the IRC from the paperback rider IRC, Applicant respectfully asserts that one of ordinary skill in the art would not combine the teachings of *Barry* and *Treleaven* as suggested in the Office Action.

In this regard, Applicant respectfully asserts that *Barry* provides no motivation whatsoever for combining the teachings of *Treleaven* to place a coupon on the outer layer or any other layer of the label assembly disclosed by *Barry*.

Based upon the reasons presented above, Applicant therefore respectfully asserts that *Barry* and *Treleaven*, viewed either singly or in combination, fail to teach or suggest, a paperback rider instantly redeemable coupon (IRC) including:

“a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner,” or

“a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof, said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first face of said first laminate being affixed to said outer section of said liner to substantially enclose said booklet between said first laminate and said liner,” or

“an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate adhesively affixed thereon, said second laminate including inner and outer sections on a first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to said outer section of said second face of said first laminate, each of said outer sections of said second laminate including perforations for permitting separation and removal of said IRC from said paperback rider IRC,” as recited in independent claim 1, as amended.

As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. Of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, as pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Since these criteria have not been met, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103 (a) should be withdrawn because *Treleaven* does not teach or suggest each feature of independent claim 1.

In view of the above arguments, Applicant respectfully requests the rejection of independent claim 1 under 35 U.S.C. § 103 be withdrawn. Additionally, claims 2, 3 and 5, which depend from independent claim 1, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

Independent claim 25

With regard to independent claim 25, Applicant respectfully asserts that *Barry* and *Treleaven* do not teach or fairly suggest a paperback rider instantly redeemable coupon (IRC) including, “a liner including inner and outer sections on a first face thereof; a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner; a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof, said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first face of said first laminate being affixed to an area of said outer section of said liner to substantially enclose said booklet between said first laminate and said liner; and an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate adhesively affixed thereon, said second laminate including inner and outer sections on a first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to an outermost area of said outer section of said liner, each of said outer sections of said second laminate including perforations for permitting separation and removal of said IRC from said paperback rider IRC,” as recited in independent claim 25, as amended.

Applicant respectfully asserts that new independent claim 25 is allowable for at least the reasons presented above for the allowance of independent claim 1, and the additional features recited therein. Additionally, claims 26, 27 and 29 which depend from independent claim 25, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 04-2223. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**DYKEMA GOSSETT PLLC**

By:

Adesh Bhargava  
Reg. No. 46,553

Dated: January 23, 2006

DYKEMA GOSSETT PLLC  
1300 I Street, N.W., Suite 300 West  
Washington, D.C. 20005  
(202) 906-8696